REMARKS

Claims 1-15, 17-23 and 26-29 are pending in this application. Claims 1, 11, 15, 22 and 26 have been amended. Claims 2-10, 12-14, 17-21, 23 and 27-29 remain unchanged. No new matter has been introduced.

Claims 1-15, 17-23, and 26-29 stand rejected under 35 USC §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant claims as his invention. The Examiner objects to the phrase "the recessed region serving to position said lower cushion surface of said first cushion spaced above the floor or ground surface, including when said first cushion deforms and flows under the wearer's weight and force of heel strike," stating that "it is not clear what structural limitations Applicant intends to encompass with such language." In response, claims 1, 22 and 26 are amended herein to include structural limitations that further characterize Applicant's invention and distinguish his invention over the prior art, as follows:

> the ~~lower surface~~ outsole further comprising a recess wall surface extending generally upwards from the lower surface toward the upper surface and defining a recessed region in communication, at its upper reaches, with ~~disposed around the~~ said aperture, ~~the recessed region serving to position~~ said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being spaced by said recessed wall surface of said outsole above the floor or ground surface at all times, including when said first cushion deforms and flows under the wearer's weight and force of heel strike.

These amendments apply also to claims 2-15 and 17-21, which depend from claim 1, to claim 23, which depends from claim 22, and to claims 27-29, which depend from claim 26.

Turning next to the rejections over the prior art. Claims 1-6, 8, 11, 13-15, 17, 22, 23 and 26 are rejected under 35 USC §102(b) as being anticipated by Schenkel (Brazil Publication No. PI 9800597-9, the Brazilian counterpart of U.S. Patent No. 6,418,641.) Claims 1, 4-6, 11, 12, 15, 17 and 26 are rejected under 35 USC §102(b) as being anticipated by Fuerst U.S. 4,897,936. Claims 1-4, 11, 15 and 26 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Preston U.S. 5,287,638 in

view of Fuerst '936. Claims 1 and 5-9 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Duclos U.S. 4,724,624 in view of Fuerst '936. Claims 1 and 10 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Parisotto U.S. 5,768,806 in view of Fuerst '936. Claims 1, 5, 6, 11 and 13-15 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Dyer et al. U.S. 5,325,611 in view of Fuerst '936. Claims 1, 3, 4, 12, 15, 17-23 and 27-29 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Pavone U.S. 6,009,637 in view of Fuerst. We respectfully traverse.

With the exception of the §102 rejection of the claims as anticipated by Schenkel, the other rejections repeat rejections made in the office action mailed July 10, 2002. Accordingly, Applicant will address the new rejection, and will address the issues raised by the Examiner in response to Applicant's arguments made in Applicant's response to the July 10, 2002 office action. Applicant maintains those arguments, but will not reiterate them in full here, for the sake of brevity.

Applicant's invention is directed to a shoe comprising an outsole sole having a cushion, disposed in an aperture of the outsole, that deforms and flows toward the floor or ground surface upon application of the wearer's weight and the force of heel strike, with the cushion remaining in a recess of the outsole, spaced, at all times, from contact with the floor or ground surface. In the shoe of Applicant's invention, the cushion is designed and constructed to flow through the aperture, but to at all times remain spaced from contact with the floor or ground surface, in order to provide the intended level of cushioning to a toddler new to walking. As recited in claim 22, in some embodiments that outsole includes first and second cushions adapted, under the wearer's weight and force of heel strike, to, respectively, deform and flow toward the floor or ground surface and deform outwardly at a cut-out portion in the sidewall.

None of the prior art references cited by the Examiner, whether taken alone, or in any proposed combination, teaches or suggests Applicant's invention.

Applicant will first discuss the newly-cited Schenkel reference. The reference numerals referred to in the following remarks are found in Schenkel's U.S. Patent No. 6,418,641.

Applicant's claims require "an aperture in the heel section extending from the upper surface to the opposite lower surface; and a resilient, deformable first cushion disposed in said aperture" and that the first cushion be "adapted to *deform and flow* toward the floor or ground surface under the wearer's weight and force of heel strike." Schenkel does not teach or fairly suggest such a cushion. Instead, Schenkel teaches a shoe including a frame 18 defining an aperture 30, and an insole 16 positioned above the frame 18. There is no teaching or suggestion by Schenkel that insole 16 is "adapted to deform and flow toward the ground or floor surface under the wearer's weight and force or heel strike" as required by Applicant's claims. While the insole 16 does "protrude or bulge in a generally downward direction through cutouts 28 and 30" (col. 3, lines 11-12), there is no suggestion that the material of the insole "flows." Nor is there any reason to expect that the materials described by Schenkel would inherently flow. Thus, Schenkel does not anticipate Applicant's claims.

As noted in Applicant's previous response, Fuerst '936 describes a sole construction for an athletic shoe having a dome-shaped portion designed to contact the floor surface during play, e.g., at col. 3, lines 24-29 Fuerst says:

> The dome-shaped portion 58 has a height less that the thickness of the outer sole and does not engage the floor or ground *until sufficient weight is applied to it by the weight of the player, at which time it will assume the configuration shown in phantom outline in FIG. 5.* [Emphasis provided]

The Examiner contends that, because Fuerst states that the central portion is "not ground engaging in normal play," the shoe disclosed by Fuerst meets Applicant's claim language. Applicant respectfully disagrees. As acknowledged by the Examiner, the central portion in the Fuerst shoe "*engages the ground under appropriate player weight distribution conditions*" (col. 1, line 67 - col. 2, line 2). Thus, the Fuerst shoe is designed with the intention that the central portion *will* engage the ground when the shoe is in use. How frequently or infrequently this occurs, or under what weight distribution conditions, is not relevant to the patentability of Applicant's claims. Applicant's shoe is designed with the intention that the cushion will *never* contact the floor or ground when the shoe is in use. Thus, Fuerst does not teach or fairly suggest an outsole having "a recess wall surface extending generally upwards from the lower surface toward the upper surface and defining a recessed region in communication, at its upper reaches,

with the aperture, said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being spaced by said recessed wall surface of said outsole above the floor or ground surface, *including when said first cushion deforms and flows under the wearer's weight and force of heel strike*," as required by Applicant's claims.

Pavone '637 teaches a shoe with modules held permanently in place, spaced from floor contact by hard rubber supports. Cushioning is provided by movement of gas among modules; and there is no teaching or suggestion of flow of cushioning material toward a floor or ground surface under the wearer's weight and force of heel strike, as recited in Applicant's claims. The Examiner asserts that, "the silicone bladder structure of Pavone would inherently flow/bulge through the openings/apertures to some degree." There is no apparent factual basis for this assertion in the Pavone reference. Instead, this rejection appears to be based solely on speculation by the Examiner. As the court pointed out in *In re Newell*, "it is well established that, in deciding that a novel combination would have been obvious, there must be some supporting teaching in the prior art. 'That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown.'" *In re Newell*, 891 F.2d 899, 901 (CAFC 1989).

As discussed in Applicant's previous response, the prior art references cited in combination with Fuerst '936 lack any teaching or suggestion for the features of Applicant's invention found lacking in Fuerst '936.

On the basis of the above, we submit that all of the claims are distinguished over the prior art and therefore in condition to be allowed.